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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/734,461
Filing Date: December 12, 2003
Appellant(s): PEMBERTON ET AL.

George Schultz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 17, 2008 appealing from the Office action mailed December 27, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

1. An Appeal Brief for the present Application (Application No. 10/734,461) was previously filed on March 14, 2007. Prosecution was reopened in a non-final Office Action mailed on May 24, 2007.

2. Application No. 11/084,540 is a commonly owned application having common subject matter. An Appeal Brief for Application No. 11/084,540 was filed on April 12, 2007. Prosecution was reopened in a non-final Office Action mailed on July 16, 2007.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,824,702	Straub	April 1989
4,348,440	Kriozere	September 1982
4,511,608	Ferraro	April 1985
5,168,831	Ittershagen et al.	December 1992

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Straub (U.S. Patent 4,824,702) in view of Ferraro (U.S. Patent 4,511,608) and Kriozere (U.S. Patent 4,348,440) and, optionally, Ittershagen et al. (U.S. Patent 5,168,831). Straub shows a plurality of continuous, unperforated double sided adhesive elements, 13, releasably adhered to and arranged side-by-side on a planar, unperforated transfer sheet, 16, and a plurality of continuous unperforated release layers, 15, each of the release layers releasably adhered on the second adhesive surface of the strips (Fig. 1), wherein the strips are adapted to be removed from the transfer sheet and releasably adhered to an article on the first adhesive surface and the release layers are adapted to be removed from the second adhesive surface revealing the second adhesive surface. Although the release layers extend slightly beyond the adhesive strips, they are substantially the same length as each of the strips. The distance which the release layers extend beyond the strip is determined by a number of factors including adhesive thickness, adhesive spreadability, and manufacturing variances (column 2, lines 52-64), but it is clear that Straub does not intend for the release layers to extend significantly beyond the adhesive strip (See Figs. 2, 4, 8). The adhesive of Straub is shown to be sufficient to hold an artificial fingernail to a finger (column 3, lines 8-10) or used as a lint remover (column 4, lines 23-36) and this tack strength would be sufficient to cause a sticking sensation. In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the strips of Straub rectangular because Straub shows nearly rectangular strips and also suggests strips of different shapes (see for example Figs. 1 and 7). The exact shape would be chosen by one of ordinary skill in

the art as a matter of design incentives or other market forces. Straub fails to show the release layers to be bisected.

Ferraro also shows a plurality of continuous, unperforated double sided adhesive elements, 5, releasably adhered to and arranged side-by-side on a planar, transfer sheet, 21, and a plurality of continuous unperforated release layers, 9, each of the release layers releasably adhered on the second adhesive surface of the strips and bisected at 19. Ferraro shows that using release layers substantially the same length as each of the strips and including a bisecting line, 19, is an alternative means for applying a double sided adhesive tape to a substrate and peeling away the release layer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the bisected release layers of Ferraro in the article of Straub because these two release layers are shown to be functionally equivalent alternate expedients.

Kriozere shows that the backing sheet, 16, 18, of a rectangular adhesive element, 12, is slit along an axis parallel to the central longitudinal axis, 20, to aid in alignment of the strip (column 1, line 65 to column 2, line 6). A similar slit along the center perpendicular to the longitudinal axis would not be as desirable because a user typically requires alignment of the long side of a rectangular article, such as when applying masking tape. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a central slit in the release sheets of the rectangular, double-sided adhesive elements of the references as combined above

because Kriozere shows that a slit along an axis parallel to the central longitudinal axis allows for alignment of a rectangular article.

Ittershagen et al. teaches that one use for double sided adhesive tapes is to prevent an animal from touching an undesired region. This is accomplished by making the top adhesive of a tack strength sufficient to cause a releasable sticking sensation to the animal (column 1, lines 17-20; column 3, lines 21-30) and the bottom adhesive layer capable of being releasably adhered to home furnishings (column 2, lines 14-16). As stated above, the tape of Straub is expected to have tack strength sufficient to cause a sticking sensation. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to purposely make the double-sided adhesive element of the references as combined above with tack strength to releasably adhere to an animal because Ittershagen et al. teaches the benefits of these adhesive materials in preventing an animal from touching undesired regions.

Regarding claims 2 and 3, Straub shows the strips are uniformly spaced apart from one another by gaps on the transfer sheet that are parallel to the length of the strips and are of a width that is equal to a substantial fraction of the width of the strips to provide an indication of an edge of the plurality of the strips.

(10) Response to Argument

Appellant first argues that the combination of Straub in view of Ferraro is ambiguous. The language of the motivational statement has been edited to clear up any possible ambiguity.

Appellant next argues that the release layers of Ferraro are not equivalent to the release layers of Straub because those of Ferraro are the same length as the adhesive strips and those of Straub must extend beyond the adhesive strip. Again the language of the rejection has been edited to indicate that it is not the length of the release layer which is considered to be equivalent, but the bisecting of the release layer. Furthermore, the rejection has been edited in view of the determination that the release layer of Straub is considered to be substantially the same length as the adhesive strip.

Applicant next argues that one of ordinary skill would not add the bisecting line of Ferraro into the adhesive strips of Straub because the bisecting line of Ferraro performs the same function as the overlapping cover sheet of Straub: removal of the release sheet from the adhesive strip. This is not an accurate description of the Straub reference. As applicant has pointed out, the extending lip of Straub is included so that in the manufacturing process, the die cut does not come in contact with the adhesive material. Whether the extending lip of Straub could also be used to remove the release sheet is conjecture because it is not disclosed by Straub. The bisecting line of Ferraro is clearly disclosed as intended for release sheet separation, therefore, one of ordinary skill in the art would add the bisecting line of Ferraro to the adhesive strips of Straub because Ferraro teaches that the bisecting line can aid in removal of the release sheet.

Appellant also argues that Straub and Ferraro fail to show a bisecting cut. Although applicant is accurate that Ferraro does not show a bisecting cut, Ferraro does show a bisecting embossed line to aid in separating the release sheet from the adhesive strip. As appellant has stated in the appeal brief, the common meaning of

bisected is "To cut or divide into two parts, especially two equal parts." As the definition clearly shows, dividing, without cutting, into two non-equal parts meets the broadest connotation of bisected. In addition, Kriozere shows the use of a bisecting cut. Although Straub and Ferraro do not specifically show the bisecting line to be a cut, the combination of Straub, Ferraro, and Kriozere do show the bisecting cut.

Regarding appellant's argument that Kriozere fails to show a bisecting cut because the cut of Kriozere is not in the center of the article, although the inventor can be his or her own lexicographer, the common meanings of words will be presumed unless a contrary definition is presented in the originally filed disclosure. The appeal brief states, "Further, Applicant has used the term "bisect" to mean "cut into two equal pieces". See for example Figure 2 at number 29 and page 5, line 14 of the specification." Page 5, line 14 of the specification states, "...release layer 27 is longitudinally bisected into two separate portions as shown by cut 29." It is noted that "bisected" is not defined in the specification and there is no indication in the text that the two separate portions are of equal size. Although Figure 2 appears to show equal sized portions of the release layer, this can in no way be considered to define bisecting as it merely shows one geometric example. As appellant has not provided convincing evidence to the contrary, it is concluded that Kriozere shows a bisecting cut line per the claimed limitations.

Appellant further argues that Kriozere would not be combinable with Straub in view of Ferraro. Appellant contends that there is no advantage to replace the embossed bisecting line of the references as combined with the axial bisecting cut of

Kriozere because the embossed bisecting line already aids in removing the release sheet and the alignment of the article is based upon the shape of a user's fingernail. By adding the bisecting cut of Kriozere into the article of the references as combined, a user can remove a first cover sheet, thereby exposing half of the adhesive, and place the exposed adhesive on either the real or artificial fingernail while grasping the portion still protected by the remaining cover sheet. In this way, the user can superimpose the adhesive strip above the fingernail, ensure that it is in the proper position without extending beyond its target, and thereafter pressing the exposed portion of the adhesive into place. Now that the adhesive is properly placed and adhered, the user can remove the remaining cover sheet and press the remainder of the adhesive strip into contact. Contrary to Appellant's assertion, this alignment is beneficial because improperly locating the adhesive strip could overlap a user's skin, which would become irritated from the adhesive, and/or extend beyond the edge of the artificial fingernail, which would be unsightly.

In response to Appellant's argument that Kriozere is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Kriozere is pertinent to the particular problem with which applicant was concerned, namely easily removing a release layer from an adhesive strip and aligning the adhesive strip on a substrate.

Appellant further argues that Ittershagen would not be combinable with either Straub in view of Ferraro and Kriozere. It is first noted that the reference to Ittershagen is now only optionally used in the rejection because it has been determined that the adhesive of Straub would produce a releasable sticking sensation. Nevertheless, in response to Appellant's argument that Ittershagen is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Kriozere is pertinent to the particular problem with which applicant was concerned, namely preventing a cat from scratching furniture.

Regarding the arguments regarding secondary considerations of non-obviousness, Appellant concludes that Appellant's increase in market share arises from advances in the art developed for applicant's product release in 1996; those advances currently being claimed. Appellant's remarks suggest that the Declaration of Bonnie Pemberton shows the claimed invention was a replacement of the prior art. The cited declaration actually suggests that the only other known double-sided adhesive tape on the market prior to 1996 was in a roll sold by the 3-M Company. There is no evidence presented suggesting that this roll sold by 3-M had any instruction on using the tape to prevent cats from clawing furniture. This being the case, the declaration does not in fact state that the invention was a replacement of the prior art, but rather implies a repackaging and remarketing of a previous product.

When the declaration further states, "With the appearance of similar products, our market share has grown from 0% to almost 80% in less than 10 years," does this market include all double-sided adhesive tapes, including the rolled adhesive tape of 3-M or only double-sided adhesive tapes marketed at cat owners for scratch prevention? The declaration originally appeared to be unclear and therefore not persuasive. In the appeal brief, appellant referred to the Supplemental Declaration which states, "...in the market of double-sided adhesive tapes for pet scratch prevention, Fe-Lines, Inc.'s share of the market has grown..." This now suggests that Appellant's market share is determined by only those products directed toward cat owners. What is still unclear, and probably unknowable, is whether the double-sided adhesive tape roll of 3-M was sold in pet stores prior to 1996. Presumably this tape has been sold in hardware stores and arts and crafts stores, but was it ever placed in a way to attract cat owners for its specific use as a cat deterrent? If not, then it is also likely that the increase in sales is a result of marketing, packaging, and perhaps advertising. Furthermore, again unknown and probably unknowable, is the percentage of double sided adhesive tape rolls purchased in establishments other than pet stores that have been used by the purchaser as a pet deterrent. Appellant states that the increase in market share is directly attributable to the particular features of the invention, but this determination is conclusory. The above mentioned factors of marketing, packaging, placement in pet stores, and disregarding sales of double sided tapes not specifically marketed for pet deterrence are all factors which could have also been involved in the increase in market

share. Without more conclusive evidence, the showings of commercial success are not persuasive.

Furthermore, the supplemental declaration states that Appellant's product is not a repackaging of the 3-M tape because the 3-M tape is not flat and does not have a bisected cover sheet. It is the examiner's position that providing the tape on a flat sheet with a bisected cover sheet are packaging changes, not changes to the product sold by 3-M, namely a double sided adhesive tape.

Appellant also includes evidence of positive comments of the product made by cat experts. These citations could also be related to the packaging of the product which has been discussed above. One of the pieces of evidence requires specific analysis. The ASPCA Seal of Approval states that "3% of the sales of the product will directly benefit ASPCA national humane programs." Although the examiner previously questioned whether this seal of approval was not a quid pro quo for the monetary percentage given to the ASPCA, the Supplemental Declaration of Bonnie Pemberton of March 16, 2007 avers that this seal of approval is a bona fide award that is not a quid pro quo for monetary compensation.

Finally, the evidence that competitors have copied Appellant's product, instructions, and packaging has been considered. The evidence presented by Appellant was weighed against the prior art as well as the cited teachings and motivations for altering the prior art. The conclusion reached from careful consideration of the evidence is that the instantly claimed invention would have been obvious to one of ordinary skill in the art.

Regarding the totality of the arguments that the commercial success and copying of appellant's packaging and instructions by others are evidence of non-obviousness, it has been well settled that these secondary considerations cannot overcome non-obviousness rejections when there is no invention. In *Leapfrog Enterprises Inc. v. Fisher-Price Inc.* 82 USPQ2d 1687 (Fed. Cir. 2007) the decision states "The district court explicitly stated in its opinion that Leapfrog had provided substantial evidence of commercial success, praise, and long-felt need, but that, given the strength of the prima facie obviousness showing, the evidence on secondary considerations was inadequate to overcome a final conclusion that claim 25 would have been obvious. We have no basis to disagree with the district court's conclusion," and the court reaffirmed that position with the conclusion "...the objective evidence of nonobviousness, including the commercial success of the Rat Zapper, copying by Woodstream, and the long felt need in the market for electronic rat traps, which was presented to the jury. Even when we presume the jury found that the objective evidence of nonobviousness favored Agrizap, this evidence is insufficient to overcome the overwhelming strength of Woodstream's prima facie case of obviousness," in *Agrazip Inc. V. Woodstream Corp.* 86 USPQ2d 1110 (Fed. Cir. 2008). In the instant application, the significant difference between the article of the primary reference to Straub and the claims under appeal is a cut line bisecting the release liner. Appellant's field of endeavor, double sided adhesive tapes, is both old and highly predictable. Adding a bisecting cut line to the release liner is a modification that is easily understood by one of ordinary skill in the art and there is ample motivation in the references for doing so. The examiner has presented a strong

prima facie case of obviousness and Appellant's evidence of secondary considerations is insufficient to overcome the obviousness rejection.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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